## REMARKS

Claims 28, 30 and 32-34 are pending. Applicants have amended claims 28, 30 and 33-34 to further define the invention. Specifically, Applicants have amended the aforementioned claims to include "automatically." Support for these amendments can be found throughout the specification, but particularly on page 8, lines 11-18 and page 9, lines 12-33. No new matter has been added. The Examiner previously rejected claims 28, 30 and 32-34 under 35 U.S.C. §103(a) as being unpatentable over Avitsur et al. (U.S. Patent No. 6,201,854) in view of Ubowski (U.S. Patent No. 6,389,125). Applicants respectfully request reconsideration of the pending claims in view of the preceding amendments and the following remarks.

**Independent claims 28 and 30**

Independent claims 28 and 30, as amended, each recite an automated telephone test apparatus configured to receive and decode DTMF signals that are indicative of a telephone number from which the DTMF signals were applied. The test apparatus retrieves from a memory stored assignment data that corresponds to the telephone number of the line to be tested. Taken here as exemplary, independent claim 28 further recites that the test apparatus is configured to "automatically compare said telephone number indicated by said retrieved assignment data with said telephone number indicated by said received and decoded DTMF signal." None of the cited references, taken alone or in combination, teach or suggest a test apparatus that "automatically" compares the telephone number from the retrieved assignment data to the telephone number indicated by the DTMF signals, as required by independent claims 28 and 30.

Rather, Avitsur et al. teaches a system and method for telephone number verification and identification in which a telephone call is initiated from the tested phone line to a dedicated telephone line at a central office switch. The central switch returns a voice announcement that may optionally be converted into text to determine the contents of the message. (See Avitsur, col. 6, lines 9-23). Specifically, Avitsur states that

> After the contents of the message have been determined according to the converted text, these contents are then stored in the database to update the database for that tested telephone line in step 9. The contents of the message could also optionally include the telephone number of the telephone line itself, in which case the telephone number has been verified, and this information is also stored in the database. (See Avitsur, col. 6, lines 36-44).

At most, Avitsur teaches that the telephone number has been verified. However, Avitsur is silent as to how the verification is implemented. Because the central office switch in Avitsur is initially received as a "voice announcement" and optionally converted into text, there is at least a suggestion that the verification is made by a user of the test equipment, not by the test equipment itself. Nonetheless, Avitsur clearly does not affirmatively teach or suggest a test apparatus programmed to "automatically compare said telephone number indicated by said retrieved assignment data with said telephone number indicated by said received and decoded DTMF signal," as required by independent claims 28 and 30. The addition of Ubowski, which the Examiner has relied upon for teaching DTMF signals, does not cure this deficiency in Avitsur. Therefore, for at least this reason, independent claims 28 and 30, and dependent claims 33 and 34 that respectively depend therefrom, are patentable over the cited art and in condition for allowance.

**No Teaching or Suggestion to Combine Avitsur and Ubowski**

A *prima facie* case of obviousness requires that there be some suggestion or motivation,

either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. See MPEP § 2143; *In re Linter*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 221 USPQ 929, 932, 933 (Fed. Cir. 1984). Moreover, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art reference for combination in the manner claimed. *In re Rouffet*, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998).

In rejecting independent claims 28, 30 and 32, the Examiner acknowledged (Final Office Action, pages 3-5 and specifically located at page 5, lines 5-6 from the bottom) that "Avitsur does not teach a DTMF decoder to decode the received line number data signals", and contended that the foregoing limitation was taught by Ubowski. Then, with no explanation and no citation of any of the prior art of record, the Examiner simply stated that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Ubowski into the teachings of Avitsur for the purpose mentioned above." *Emphasis added.*

Merely alleging that the combination of references would be obvious "for the purpose mentioned above" fails to establish a *prima facie* case of obviousness with respect to the claimed invention. Moreover, simply extracting elements from references and combining them in the manner claimed, absent some teaching or suggestion supporting the combination, is an inappropriate application of hindsight in light of Appellants' disclosure. The Examiner is required

to provide some reason, suggestion or motivation as to why one of ordinary skill in the art would have modified Avitsur to achieve the claimed invention. That knowledge cannot come from the disclosure of Appellants' invention itself. *In re Oetiker*, 977 F.2d 1433, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992).

For at least the reasons set forth above, the Examiner has failed to establish a *prima facie* case of obviousness against the pending claims. Accordingly, the Examiner's rejection of claims 28, 30, and 32-34 should be reversed.

## CONCLUSION

Reconsideration and allowance are respectfully requested. In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 00-VE20.59DIV1 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136 is hereby made, the fee for which should also be charged to this Deposit Account.

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Respectfully submitted,

By _____

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